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24

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 May 2004_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-12,14-23 and 35-51_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-12,14-23 and 35-51_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _23_.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claims 1-12, 14-23, and 35-51 are pending and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 May 2004 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-12, 14-23, and 35-51 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12, 14-23, and 35-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 324 553 B1 to Cragun et al. in view of US Patent 5 918 014 A to Robinson et al.

Regarding claim 1, Cragun discloses a computer-implemented method of controlling content, the method comprising:

receiving input from a user; (column 2, lines 26-36, specifically lines 31-32)

monitoring content in a processing environment to be accessed by the user and determining whether monitored content includes a predetermined advertisement. (column 2, lines 1-9 and 26-36; column 4, lines 42-64)

Cragun does not disclose wherein if the monitored content includes the predetermined advertisement, replacing the predetermined advertisement with another predetermined advertisement based on the user input, whereby the predetermined advertisement that is included in the monitored content is removed from the monitored content and replaced, however, Cragun does disclose the predetermined advertisement that is included in the monitored content is removed from the monitored content (column 2, lines 1-9 and 26-31, specifically lines 33-35) to allow a user decide which images of advertisements to display (column 2, lines 34-36) and replacing the corresponding predetermined advertisement with a blank display element (column 15, lines 53-63).

Robinson discloses replacing a predetermined advertisement included in content with another predetermined advertisement based on a user's input (column 4, lines 8-14; column 5, lines 4-9).

Robinson discloses that the replacement of an advertisement enables the user to reject an ad that the user does not have any interest in seeing (column 5, lines 4-9).

Based on the specific advantages described above in Robinson regarding the replacement of an advertisement included in content and wherein both references are directed towards advertisements placed within content that are displayed based on the user's preferences (column 2, lines 26-36, specifically lines 34-36 of Cragun; column 5, lines 4-9 of Robinson), one of ordinary skill in the art would have found it obvious to combine the teachings of these references because one of ordinary skill in the art would have appreciated the specific advantages of the secondary reference and would have considered the secondary reference to be analogous art.

Therefore, it would have been obvious to achieve the limitations as described in the claim.

Claim 18 is also rejected since this claim recites a computer-readable medium that contains substantially the same limitations as recited in claim 1.

Regarding claim 2, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein receiving input from the user comprises receiving information about content that the user wishes to control. (column 2, lines 26-36, specifically 31-32)

Claim 46 is also rejected since this claim recites a method that contains substantially the same limitations as recited in claim 2.

Regarding claim 3, Cragun and Robinson disclose the method of claim 2.

Cragun does not disclose further comprising generating the other predetermined advertisement based on the received user information, however, Robinson does disclose this limitation (column 5, lines 4-9).

Claim 3 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 4, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein monitoring content comprises monitoring content in a database manager, a spreadsheet, a communications package, a graphics program, a word processor, or a network browser. (column 2, lines 26-36; column 4, lines 42-64)

Regarding claim 5, Cragun and Robinson disclose the method of claim 1.

Cragun does not disclose wherein receiving input from the user comprises receiving information from an organization designated by the user, however, Robinson does disclose this limitation (column 6, lines 52-column 7, lines 16, specifically column 6, lines 54-58).

Claim 5 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 6, Cragun and Robinson disclose the method of claim 5.

Cragun does not disclose the method further comprising generating the other predetermined advertisement based on received organization information, however, Robinson does disclose this limitation (column 6, lines 52-column 7, lines 16, specifically column 6, lines 54-58).

Claim 6 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 1.

Regarding claim 7, Cragun and Robinson discloses the method of claim 1.

Cragun discloses wherein monitoring content comprises monitoring text, video, audio, image, animation, or document link in the application program. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 8, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein monitoring content comprises monitoring information related to the originator of content. (column 2, lines 26-36; column 4, lines 42-64)

Claim 45 is rejected since this claim recites a method that contains substantially the same limitations as recited in claim 8.

Regarding claim 9, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein monitoring content comprises monitoring content exchanged between a network browser and a network server. (column 4, lines 42-64)

Regarding claim 10, Cragun and Robinson disclose the method of claim 1.

Cragun discloses further comprising activating rules ("blocking list") including generating rules using the received user input and updating rules using the received user input and the generated rules. (column 2, lines 26-36, specifically lines 33-36; column 12, lines 52-67)

Regarding claim 11, Cragun and Robinson disclose the method of claim 10.

Cragun discloses wherein determining whether monitored content includes a predetermined advertisement comprises extracting an identifier from the content; and

using the rules comparing the extracted identifier with a predetermined set of identifiers

that correspond to a predetermined set of advertisements. (column 15, lines 30-63)

Regarding claim 12, Cragun and Robinson disclose the method of claim 11.

Cragun does not disclose wherein if the extracted identifier matches one of the

predetermined sets of identifiers, replacing the corresponding predetermined

advertisement with the other predetermined advertisement, however, Cragun does

disclose wherein if the extracted identifier matches one of the predetermined sets of

identifiers, replacing the corresponding predetermined advertisement with a blank

display element (column 15, lines 53-63)

Robinson discloses replacing a corresponding predetermined advertisement with

another predetermined advertisement (column 4, lines 8-14; column 5, lines 4-9).

Claim 12 is rejected since the motivations regarding the obviousness of claim 1

also apply to claim 12.

Regarding claim 14, Cragun and Robinson disclose the method of claim 1.

Cragun does not disclose wherein replacing the predetermined advertisement

with another predetermined advertisement comprises replacing the predetermined

advertisement with text, video, audio, image, animation, or a link to a document,

however, Robinson does disclose this limitation (column 4, lines 8-14; column 5, lines 4-

9).

Claim 14 is rejected since the motivations regarding the obviousness of claim 1

also apply to claim 14.

Regarding claim 15, Cragun and Robinson disclose the method of claim 1.

Cragun does not disclose wherein replacing the predetermined advertisement with another predetermined advertisement comprises accessing the other predetermined advertisement from a user's computer or from a network server, however, Robinson does disclose this limitation (column 4, lines 8-14; column 5, lines 4-9).

Claim 15 is rejected since the motivations regarding the obviousness of claim 1 also apply to claim 15.

Regarding claim 16, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein monitoring occurs at the user's computer system. (column 8, lines 59-64)

Regarding claim 17, Cragun and Robinson disclose the method of claim 1.

Cragun discloses wherein monitoring occurs at a network server separate from the user's computer. (column 8, lines 59-64, specifically lines 60-62)

Regarding claim 19, Cragun discloses a computer system for controlling content, the system comprising a client computer programmed to receive input from a user and to operate an application program ("browser") in a processing environment (column 2, lines 26-36) and a second computer ("server") interconnected with the client computer by an internetwork (column 1, lines 37-47).

Cragun does not disclose wherein the second computer is programmed to observe content in the processing environment to be accessed by the user, determine whether observed content includes a predetermined advertisement, and if the observed content includes the predetermined advertisement, replace the predetermined

advertisement with a predetermined identifier ("tag") that corresponds to another predetermined advertisement based on the user input, whereby the predetermined advertisement that is included in the observed content is removed from the observed content and replaced.

However, Cragun does disclose wherein the client is programmed to observe content in the processing environment to be accessed by the user and determine whether observed content includes a predetermined advertisement (column 2, lines 1-9 and 26-36; column 4, lines 42-64) and wherein the predetermined advertisement that is included in the monitored content is removed by the client computer from the monitored content (column 2, lines 1-9 and 26-31, specifically lines 33-35) to allow a user decide which images of advertisements to display (column 2, lines 34-36) and replacing the corresponding predetermined advertisement with a blank display element (column 15, lines 53-63).

Robinson discloses replacing a predetermined advertisement included in content with another predetermined advertisement based on a user's input (column 4, lines 8-14; column 5, lines 4-9). Robinson also discloses that a server replaces the advertisement (column 4, lines 39-42, specifically line 42; column 19, lines 27-30)

Robinson discloses that the replacement of an advertisement enables the user to reject an ad that the user does not have any interest in seeing (column 5, lines 4-9) and that the replacement of the advertisement is done automatically by a server without user intervention (column 4, lines 39-42, specifically line 42; column 5, lines 8-9; column 19, lines 27-30)

Based on the specific advantages described above in Robinson regarding the replacement of an advertisement included in content and wherein both references are directed towards advertisements placed within content that are displayed based on the user's preferences (column 2, lines 26-36, specifically lines 34-36 of Cragun; column 5, lines 4-9 of Robinson), one of ordinary skill in the art would have found it obvious to combine the teachings of these references and modify Cragun to use a server to operate the method as disclosed in Robinson because one of ordinary skill in the art would have appreciated the specific advantages of the secondary reference and would have considered the secondary reference to be analogous art.

Therefore, it would have been obvious to achieve the limitations as described in the claim.

Regarding claim 20, Cragun and Robinson disclose the computer system of claim 19.

Cragun does not disclose the computer system further comprising a second set of instructions for programming the second computer to: receive the predetermined identifier; and replace the predetermined identifier with the corresponding other predetermined advertisement, however, Cragun does disclose a predetermined identifier ("tag") and replacing the predetermined identifier with a blank display element (column 15, lines 53-63).

Robinson discloses replacing a predetermined advertisement with another predetermined advertisement based on a user's input (column 4, lines 8-14; column 5, lines 4-9).

Claim 20 is rejected since the motivations regarding the obviousness of claim 19 also apply to this claim.

Regarding claim 21, Cragun discloses a computer-implemented method of controlling content in a processing environment to be accessed by the user, the method comprising:

receiving an input from the user; (column 2, lines 26-36, specifically lines 31-32)

observing content in the processing environment to be accessed by the user; and determining whether observed content includes predetermined advertisement content would direct the user to a predetermined advertisement ("hotlinks") (column 1, lines 55-57; column 2, lines 1-9 and 26-36; column 4, lines 42-64).

Cragun does not disclose wherein if the observed content includes predetermined advertisement content that would direct the user to the predetermined advertisement, replacing the observed content with other content that directs the user to another predetermined advertisement based on the user input, whereby the predetermined advertisement content that is included in the observed content is removed and replaced, however, Cragun does disclose the predetermined advertisement content that is included in the monitored content is removed from the monitored content (column 2, lines 1-9 and 26-31, specifically lines 33-35) to allow a user decide which images of advertisements to display (column 2, lines 34-36) and replacing the corresponding predetermined advertisement content with a blank display element (column 15, lines 53-63).

Robinson discloses replacing a predetermined advertisement with another predetermined advertisement based on a user's input (column 4, lines 8-14; column 5, lines 4-9).

Robinson discloses that the replacement of an advertisement enables the user to reject an ad that the user does not have any interest in seeing (column 5, lines 4-9).

Based on the specific advantages described above in Robinson regarding the replacement of an advertisement included in content and wherein both references are directed towards advertisements placed within content that are displayed based on the user's preferences (column 2, lines 26-36, specifically lines 34-36 of Cragun; column 5, lines 4-9 of Robinson), one of ordinary skill in the art would have found it obvious to combine the teachings of these references because one of ordinary skill in the art would have appreciated the specific advantages of the secondary reference and would have considered the secondary reference to be analogous art.

Therefore, it would have been obvious to achieve the limitations as described in the claim.

Claim 22 is rejected since this claim recites software in a computer readable medium that contains substantially the same limitations as recited in claim 21.

Claim 23 is rejected since this claim recites a computer system that contains substantially the same limitations as recited in claims 19 and 21 in combination.

Regarding claim 35, Cragun discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising:

receiving input from a user; (column 2, lines 26-36, specifically lines 31-32)

monitoring content in the processing environment to be accessed by the user; and determining whether monitored content includes a predetermined advertisement (column 2, lines 1-9 and 26-36; column 4, lines 42-64).

Cragun does not disclose the method wherein if the monitored content includes the predetermined advertisement, selecting a selected advertisement, based on the user input, for incorporation into the content; and causing the content to be accessed by the user with the selected advertisement incorporated therein, wherein the predetermined advertisement that is included in the monitored content is removed and replaced whenever the selected advertisement differs from the predetermined advertisement, however, Cragun does disclose the predetermined advertisement that is included in the monitored content is removed from the monitored content (column 2, lines 1-9 and 26-31, specifically lines 33-35) to allow a user decide which images of advertisements to display (column 2, lines 34-36) and replacing the corresponding predetermined advertisement with a blank display element (column 15, lines 53-63).

Robinson discloses selecting a selected advertisement, based on the user input, for incorporation into the content; causing the content to be accessed by the user with the selected advertisement incorporated therein and replacing a predetermined advertisement included in content with another predetermined advertisement based on a user's input (column 4, lines 8-14; column 5, lines 4-9).

Robinson discloses that the replacement of an advertisement enables the user to reject an ad that the user does not have any interest in seeing (column 5, lines 4-9).

Based on the specific advantages described above in Robinson regarding the replacement of an advertisement included in content and wherein both references are directed towards advertisements placed within content that are displayed based on the user's preferences (column 2, lines 26-36, specifically lines 34-36 of Cragun; column 5, lines 4-9 of Robinson), one of ordinary skill in the art would have found it obvious to combine the teachings of these references because one of ordinary skill in the art would have appreciated the specific advantages of the secondary reference and would have considered the secondary reference to be analogous art.

Therefore, it would have been obvious to achieve the limitations as described in the claim.

Regarding claim 36, Cragun and Robinson disclose the method of claim 35.

Cragun does not disclose wherein the predetermined advertisement is one of a plurality of advertisements from which the selected advertisement is selected, however, Robinson does disclose this limitation (column 4, lines 9-14 and 50-67).

Claim 36 is rejected since the motivations regarding the obviousness of claim 35 also apply to this claim.

Claim 50 is also rejected since this claim recites a method that contains substantially the same limitations as recited in claim 36.

Regarding claim 37, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user is content to be viewed by the user. (column 2, lines 26-36)

Regarding claim 38, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user comprises text. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 39, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user comprises video. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 40, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user comprises sounds. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 41, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user comprises images. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 42, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the content to be accessed by the user comprises movies. (column 4, lines 42-64, specifically lines 43-48 and 58-61)

Regarding claim 43, Cragun and Robinson disclose the method of claim 35.

Cragun and Robinson do not disclose wherein the processing environment through which the content is accessed by the user comprises a television for receiving television signals that carry the content.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re*

Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32

F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at

the time the invention was made to include the nonfunctional descriptive material with

the claimed invention because such data does not functionally relate to the steps in the

method claimed and because the subjective interpretation of the data does not

patentably distinguish the claimed invention.

Regarding claim 44, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the processing environment is a computer application

program or a communication channel between an operating system residing at a users

computer system and the computer application program. (column 2, lines 26-36; column

4, lines 42-64)

Regarding claim 47, Cragun and Robinson disclose the method of claim 35.

Cragun discloses wherein the step of receiving input from a user comprises

observing information relating to the user and generating content preferences based on

these observations. (column 2, lines 26-36, specifically lines 31-36)

Claim 48 is rejected since this claim recites software in a readable medium that

contain substantially the same limitations as recited in claim 35.

Claims 49 and 51 are rejected since these claims recite a method and software

in a computer-readable medium that contain substantially the same limitations as

recited in claims 21 and 35 in combination.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

US Patent 6 029 045 A to Picco et al;

US Patent 6 128 655 A to Fields et al;

US Patent 6 408 055 B1 to Kokubun;

US Patent 6 459 440 B1 to Monnes et al;

US Patent 6 577 716 B1 to Minter et al.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to George C Neurauter, Jr. whose telephone number is

703-305-4565. The examiner can normally be reached on Thursday 1-2pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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